

## REMARKS

### Amendments in the specification

The title has been amended to better coincide with the invention as now claimed.

### Amendments in the claims

Following amendment as requested herein, the following claims are pending in the present application: Claim 7. Claims 1 and 3 have been cancelled herein. Matter not originally filed with this specification, *i.e.* new matter, is not introduced by the present amendment and no change in inventorship is believed to result. Specifically:

Claim 7 is amended herein to incorporate the method of originally filed Claim 3 in light of the cancellation of Claim 3. This amendment is supported at least by originally filed Claims 3 and 7. Claim 7 is further amended to focus on an embodiment of the invention wherein the claimed golden zebrafish is suitable for ornamental use. This amendment is supported at least by [0002] of the application as published.

### RESPONSE TO OFFICE ACTION DATED 17 MARCH 2008

#### 1. Rejection under 35 U.S.C. §112, second paragraph

Claim 7 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Action alleges that the phrase “on skeletal muscle” is unclear as it is not known whether the claim is requiring deposition of the RFP on the muscle of just expression in the cells of the muscle. In response, Applicant has amended Claim 7 to read “in skeletal muscle cells”.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the present rejection under 35 U.S.C. §112, second paragraph.

#### 2. Rejection under 35 U.S.C. §103(a)

##### 2.1 Claims 3 and 7

Claims 3 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Hsiao C., *et. al.* in view of Carvan, *et. al.* and Finley, *et. al.* (already made of record). Claim 3 has been cancelled herein, therefore the rejection as to Claim 3 is now moot. This rejection is

respectfully traversed with regard to Claim 7.

Claim 7, as amended herein is directed to an adult golden zebrafish, suitable for ornamental use, which exhibits red fluorescence in skeletal muscle cells and produced by the method recited therein.

First, none of the cited documents teach or suggest the use of such fluorescent transgenic fish as ornamental fish. Hsiao reported that a transgene flanked by AVV-ITRs can be used effectively to analyze promoter activity and specificity in assays of transient and stable transgene expression (p333, column 1. last paragraph). Carvan developed transgenic lines in which DNA motifs that respond to selected environmental pollutants are capable of activating a reporter gene that can be easily assayed. In addition, Carvan reported that the transgenic technology can be developed for a simple, exquisitely sensitive and inexpensive assay for monitoring aquatic pollution (Abstract). Finley reports the use of DsRed as a reporter gene. However, Finley focuses on the multiple labels in individual zebrafish cells, and reported that it can be applied to investigations including multiple, independent tags of transgenic fish lines, lineage studies of wild type proteins expressed using polycistronic messages and the detection of protein-protein interactions at the subcellular level using fluorescent protein fusions.

Applicant was the first to discover that the particularly disclosed DsRed gene construct (flanked by ITRs, and operably linked with an  $\alpha$ -actin promoter that replaced a CMV promoter, and with an SV 40 ploy A) can generate red fluorescent transgenic golden zebrafish **suitable for ornamental use** by injecting the linearized gene construct into a golden zebrafish. It was also selected as one of the coolest inventions in 2003 and reported by Time Magazine (see attached). The Applicant requests that the current claim be reconsidered under secondary consideration since it has been successfully developed as commercial merchandise for ornamental use for the first time at the time of filing.

## 2.2 Claim 1

Claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly obvious over Hsiao C., *et. al.* in view of Finley, *et. al.* (already made of record). Applicant has cancelled Claim 1, therefore this rejection is now moot.

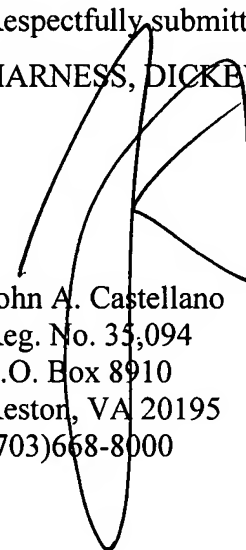
Therefore, Applicant respectfully requests reconsideration and withdrawal of the present rejection under 35 U.S.C. §103(a).

3. Conclusion

It is believed that all of the stated grounds of rejection are properly traversed, accommodated or rendered moot herein. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that the present response is a full and complete response to the outstanding Action and that the application is in condition for allowance.

Should any issues remain, the Examiner is invited to call the undersigned at the telephone number given below.

Respectfully submitted,  
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Attachment:

TIME magazine: Coolest Inventions 2003, Glowing Fish